

REMARKS

The present Amendment is in response to the Official Action mailed January 23, 2008. Claim 1 has been amended herein, and claims 6-8 have either been previously canceled or canceled herein. Thus, claims 1-5 and 9-18 remain currently pending in the present case. The following sets forth Applicants' remarks pertaining to the currently pending claims and the outstanding Action.

As an initial matter, Applicants respectfully thank the Examiner for conducting the telephone interviews of March 26 and 27, 2008 with their undersigned counsel. Those interviews were precipitated by both the outstanding Action and the fact that a previous interview was conducted with the Examiner and his supervisor. In that earlier telephone interview, both the Examiner and his supervisor agreed that the previously submitted amendments overcame the rejections set forth in an earlier Action. In fact, both the Examiner and his supervisor agreed that the amendments moved the present case into a condition of allowance. Applicants were thusly somewhat surprised by the issuance of the outstanding Action. Nonetheless, in the March 27th telephone interview, the Examiner and the undersigned counsel came to agreements regarding the above amended claims. These will be discussed below.

The rejections set forth in the Official Action can best be split up into two categories, (1) the rejections of claims 1-5 and 7-9 and (2) the rejections of claims 10-18. Applicants will address the latter of these sets first. In the Action, the Examiner set forth the following rejections in connection with the second set:

- Claim 10 under 35 U.S.C. § 103(a) as being obvious over the combination of U.S. Patent No. 5,314,477 to Marnay ("Marnay") and U.S. Patent No. 5,733,290 to McCue et al. ("McCue");

- Claims 11-17 under 35 U.S.C. § 103(a) as being obvious over the combination of Marnay, McCue and U.S. Patent No. 6,235,034 to Bray ("Bray"); and
- Claim 18 under 35 U.S.C. § 103(a) as being obvious over the combination of Marnay, McCue, Bray, and U.S. Patent No. 6,413,259 to Lyons et al. ("Lyons").

In the aforementioned March 26th telephone discussion with the Examiner, Applicants' counsel pointed out Applicants' position that one of ordinary skill in the art at the time of the present invention would not have combined the Marnay and McCue references in rejecting independent claim 10. In addition, an argument was put forth by Applicants' counsel that even the combination of Marnay and McCue did not teach each and every one of the limitations of independent claim 10. Specifically, the Examiner cited element 811 of Marnay (see FIG. 10) as being an insertion plate capable of maintaining first and second members of an articulating intervertebral disc replacement device in registration with one another during their insertion into the intervertebral disc space. Applicants' counsel pointed out that the insertion device of Marnay (of which element 811 is merely one component) is actually directed to a device capable of holding first and second members of an articulating intervertebral disc replacement device and thereafter spreading them to engage the adjacent vertebrae. Element 811, which has relied upon by the Examiner as being an insertion plate, is actually only designed to engage one of the first or second members of the intervertebral disc replacement device. It was thusly conveyed to the Examiner that Marnay simply does not teach an element which performs the function of holding both the first and second members in registration with one another, as does the insertion plate of the present invention. Subsequent to the March 26th telephone interview, the

Examiner considered Applicants' arguments and, in the March 27th telephone discussion, indicated that independent claim 10 was in fact allowable over Marnay and McCue. As such, no amendments of independent claim 10, or any of its dependent claims, have been submitted with the present Amendment.

Although Applicants still maintain the improper nature of the combination of Marnay and McCue (McCue is directed to a tool for use in placing a tibial implant and is simply not analogous prior art), they respectfully submit that by way of the Examiner's indications, independent claim 10 constitutes allowable subject matter. Furthermore, because of their proper dependence upon independent claim 10, or an intervening claim, claims 11-18 also constitute allowable subject matter. Thus, allowance of those claims is respectfully requested.

With regard to the second set of rejections mentioned above, Applicants note that the Examiner set forth the following rejections in the outstanding Action:

- Claims 1-5, 7 and 8 under 35 U.S.C. § 103(a) as being obvious over the combination of Marnay and U.S. Patent No. 6,991,654 to Foley ("Foley"); and
- Claim 9 under 35 U.S.C. § 103(a) as being obvious over the combination of Marnay, Foley, and U.S. Patent Application Publication No. 2003/0093153 to Banick et al. ("Banick").

In the aforementioned telephone interviews, Applicants' undersigned counsel presented arguments as to the improper combination of Marnay and Foley. Namely, Applicants still believe that although Marnay relates to a multi-piece articulable intervertebral disc replacement device, Foley only relates to a spinal fusion device made up of a single element. Applicants respectfully submit that one of ordinary skill in the art would not have looked to a reference in the spinal fusion arts and combined such with Marnay in order to arrive at the

present invention. After presenting this argument to the Examiner in the March 26th telephone discussion, the Examiner, in the follow-up conversation of March 27th, indicated that he was not persuaded by same. However, the Examiner indicated that amending independent claim 1 to include similar limitations as certain of those in independent claim 10 (i.e., the recitation of an insertion plate and a detachable handle), would overcome the rejections in view of Marnay and Foley. Applicants' counsel pointed out that the subject matter of previously presented dependent claims 7 and 8 included this subject matter and suggested that independent claim 1 be amended to include same. The Examiner agreed with Applicants' counsel.

As such, independent claim 1 has been amended above to include the limitations of previously presented dependent claims 7 and 8. Those dependent claims have been cancelled. Applicants do note that certain of the language has been refined in order to comport with the other language of claim 1. Specifically, claim 1 has been amended to include a step of providing an insertion plate and a handle that is adapted to detachable engage the insertion plate. Applicants respectfully submit that this claim comports with that which the Examiner acknowledged was allowable. Because claims 2-5 and 9 properly depend from independent claim 1, they also constitute allowable subject matter.

In light of all of the above, Applicants respectfully request allowance of each and every one of the currently pending claims. Should the Examiner once again determine that the above claims, as amended, do not constitute allowable subject matter, he is requested to contact Applicants' counsel directly (at (908) 654-5000), in lieu of issuing another formal written rejection in the matter.

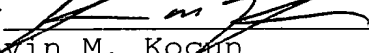
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If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

Dated: April 7, 2008

Respectfully submitted,

By 
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